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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,773	07/15/2003	James W. Hodges	60680-1802	8782
10291	7590	01/12/2006	EXAMINER	
RADER, FISHMAN & GRAUER PLLC 39533 WOODWARD AVENUE SUITE 140 BLOOMFIELD HILLS, MI 48304-0610			PICKARD, ALISON K	
			ART UNIT	PAPER NUMBER
			3673	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/619,773

**Applicant(s)**

HODGES, JAMES W.

**Examiner**

Alison K. Pickard

**Art Unit**

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10 and 12-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input checked="" type="checkbox"/> Other: <u>906</u>                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jelinek in view of Terai.

Jelinek discloses a gasket method of making a gasket comprising a metal base sheet 12 having at least one aperture 18 bound by an edge wherein one or more coined angles 20 (see col. 2, line 18) are formed at the edge and an elastomeric material (silicone rubber) 22 is disposed on the angles to form a sealing bead.

Jelinek does not disclose that a texture is applied to the coined angles. Terai teaches a gasket and method of making a gasket having an elastomer applied to a region of a base sheet. Terai teaches applying a texture 21 at the region the elastomer is to be applied to improve the adhesion (see col. 2, lines 61-65). Regarding claims 13 and 14, Terai teaches the texture can be the addition of a primer 41 to improve adhesion (col. 7, 54- 8, 5). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to apply a texture to the coined angles of the base sheet to improve adhesion of the elastomer applied thereto as taught by Terai.

Regarding claim 5, while Jelinek discloses a substantially thin base sheet, Jelinek does not appear to disclose a thickness of 1.0mm. It is not considered inventive to discover the

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workable or optimum ranges by routine experimentation absent the showing of criticality for such ranges. See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the base sheet 1.0mm thick.

3. Claims 1, 3, 4, 6-10, and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jelinek in view of Fujino in view of Terai.

Jelinek discloses a gasket method of making a gasket comprising a metal base sheet 12 having at least one aperture 18 bound by an edge wherein one or more coined angles 20 (see col. 2, line 18) are formed at the edge and an elastomeric material (silicone rubber) 22 is disposed on the angles to form a sealing bead. Jelinek does not disclose the coined angles are defined by a gradual reduction in thickness toward the edge of the sheet. Fujino teaches a gasket having a metal base sheet with an aperture bound by an edge wherein one or more coined angles are formed at the edge and an elastomeric material is disposed on the angles to form sealing beads. Fujino teaches art equivalent shapes (coined angles) used at the edge (see Figs 3I-3III). Figure 3III shows an angle/shape similar to that in Jelinek and figures 3I and 3II show a gradual reduction in thickness. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the coined angles of Jelinek with a coined angle having a gradual reduction in thickness, as such are art equivalent angles as taught by Fujino.

Jelinek does not disclose that a texture is applied to the coined angles. Terai teaches a gasket and method of making a gasket having an elastomer applied to a region of a base sheet. Terai teaches applying a texture 21 at the region the elastomer is to be applied to improve the adhesion (see col. 2, lines 61-65). Regarding claims 13-15, Terai teaches the texture can be the

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addition of a primer 41 to improve adhesion (col. 7, 54- 8, 5). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to apply a texture to the coined angles of the base sheet to improve adhesion of the elastomer applied thereto as taught by Terai.

Regarding claims 16-19, neither Jelinek nor Fujino appear to disclose the claimed angles. It is not considered inventive to discover the workable or optimum ranges by routine experimentation absent the showing of criticality for such ranges. See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the angles in the claimed ranges.

4. Claims 1, 3-7, 9, 12, 13, 15-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujino in view of Terai.

Fujino discloses a gasket comprising a metal base sheet A having at least one aperture bound by an edge wherein one or more angles (see Figs. 3I-3III) defined by a gradual reduction in thickness is formed at the edge and an elastomeric material 7 is disposed on the angles to form a sealing bead. Requiring the angles to be coined is considered a process in a product claim and is given little patentable weight.

Fujino does not disclose that a texture is applied to the coined angles. Terai teaches a gasket and method of making a gasket having an elastomer applied to a region of a base sheet. Terai teaches applying a texture 21 at the region the elastomer is to be applied to improve the adhesion (see col. 2, lines 61-65). Regarding claims 13 and 15, Terai teaches the texture can be the addition of a primer 41 to improve adhesion (col. 7, 54- 8, 5). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to apply a texture

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to the coined angles of the base sheet to improve adhesion of the elastomer applied thereto as taught by Terai.

Regarding claims 5 and 16, 17, and 19, Fujino does not disclose the base has a thickness of 1.0mm or the claimed angles. It is not considered inventive to discover the workable or optimum ranges by routine experimentation absent the showing of criticality for such ranges. See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the base with a thickness of 1.0mm and the claimed angles.

#### ***Response to Arguments***

5. Applicant's arguments filed 7-11-05 have been fully considered but they are not persuasive, and are moot in view of the new grounds for rejection.

Regarding Jelinek: Jelinek discloses a coined angle at an edge. The three surfaces of lip 20 (coined angle) clearly increase the surface area of the edge of aperture 18 (i.e. versus if the lip were not there and it was just one cylindrical bore). Thus, the claim language is met. It is well known that increased surface area increases the bonding strength.

Regarding Fujino: Fujino's Figures 3I and 3II are very similar to applicants Figure 2 (especially 3II even though it's not as pronounced as Applicant's). Fujino clearly discloses and teaches the use of angles to create a gradual reduction in thickness at an edge. These angles increase the surface area and thus the bonding strength. Also, Figures 3I and 3II do not have the corners that Applicant argues.

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Regarding Terai: Terai teaches the use of a roughened surface or a primer to improve the adhesion of an elastomer to a base sheet. It is this teaching being applied to Jelinek and Fujino to further increase the adhesion between the elastomer and edge.

Regarding new claims 16, 18, and 19, the specification does not appear to specifically disclose the claimed range. However, the specification does state that the angles may extend at any angle with respect to the axis (page 3, last 2 lines). Therefore, this is not considered new matter. However, the specification does not and cannot associate any criticality with the claimed range. Therefore, using this range is considered obvious.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on 571-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alison K. Pickard  
Primary Examiner  
Art Unit 3673

AP





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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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20050926

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

This action is being remailed because it appears it was inadvertently sent back to the office rather than to applicant. The time period for response starts from the mail date of THIS communication.

Alison K. Pickard  
Primary Examiner  
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